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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,583	04/17/2000	YAARIT SILVERSTONE	AND1P584	1125

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/550,583

Applicant(s)

SILVERSTONE ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment/ Withdrawn of Finality

1. Applicant's request, received on 2/2/2005 for reconsideration of the finality of the rejection of the last Office action (mailed on 9/1/2004) is persuasive and, therefore, the finality of that action is withdrawn. Claims 1-3, 8-10, 11-24 have been amended. Amendment is acknowledged and entered. Currently claims 1-14 and 22-28 are pending for examination.

Response to Arguments

2. Applicant's arguments, see Remarks pages 8-20, filed 2/2/2005, with respect to rejection of claims 1-14 and 22-28 have been fully considered but are moot in view of new ground(s) of rejection, that is in view of US patent 6,298,513 to Thackston, US patent 6,343,279 to Bissonette et al., hereinafter referred to Bissonette, and Elance.com (1198), necessitated due to amendments made to claims 1-3, 8-10, 11-24 . The amendments to claims 1-3, 8-10, 11-24 has changed the breadth of the claimed inventions and narrowed down the scope by replacing the term "service provider data structures" by –manufacturing service provider data structures-. The scope of the service provider restricted to manufacturing only, that is producing goods/products. Before the current amendment the term " service provider data structures" provided a broad scope of comprising service providers for both manufacturing and other management services that are needed in the operations of a company and are different from the manufacturing products. This is a Final rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3.1. Claims 1-14 and 22-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1-14 and 22-28 recite the term " manufacturing service provider data structures", which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's specification recites providing a database including a plurality of " service provider data structures". The applicant while making current amendments to claims 1-3, 8-10, 11-24 has narrowed down the breadth of the invention by replacing the term "service provider data structures" by -manufacturing service provider data structures-, with scope of the service provider restricted to manufacturing only, that is producing goods/products. Before the current amendment the term " service provider data structures" provided a broad scope of comprising service providers for both manufacturing and other management services that are needed in the operations of a company and are different from the manufacturing products. The disclosure specifies

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that a service provider data structures include various types of services including manufacturing, installation, selling, reselling, etc, but does not disclose a manufacturing service provider data structures including various types of services including manufacturing, installation, selling, reselling, legal services, etc. In order to conform with the disclosure the claims should recite " service provider data structures" instead of " manufacturing service provider data structures".

Claims 3, 10 and 24 recite that the manufacturing service provider data structures further include data concerning legal services. For reasons, analyzed above, the applicant's disclosure does not disclose a manufacturing service provider data structure, which is intended for producing goods, includes legal services.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.1. Claims 1 –14 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8 and 28 are directed to a contract manufacturing framework comprising of steps providing a database for manufacturing service providers including description about them for the intended use of identifying a suitable service provider based upon the user's data and then allowing the user to place an order. The invention as recited in claim 1 also recites that database includes a plurality of hyperlinks,

identifying a hyperlink based upon the same request on the basis of which a manufacturing service provider is identified and then sending the identified hyperlink to the user for obtaining additional information. The invention as recited in claim 1 fails to recite a useful connection between the identified hyperlink and additional information to be obtained from this hyperlink with the manufacturer service provider and therefore it is unclear what is the utility of storing, identifying and sending the hyperlink for obtaining additional information and thus renders the claims 1, 8, and 28 indefinite. Even if all the limitations with respect to hyperlinks are omitted the inventions of claims 1, 8 and 28 could stand alone. Since claims 2-7 and 9-14 are dependencies of claims 1 and 8 respectively they also inherit the same deficiency.

4.2. Claims 2-3, 9-10 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 9 and 23 recite the limitation "the service provider". There is insufficient antecedent basis for this limitation in the claim. Claims 1, 8 and 22 recite the term "manufacturing service provider" and therefore, "the service provider" term is to be replaced by ---manufacturing service provider--. Since claims 3, 10 and 24 are dependencies of claims 2, 9 and 23 respectively they also inherit the same deficiency.

Note: Claims 1-2 are method/process claims wherein the novelty of invention lies in the manipulative steps. Claim 3 recites that the manufacturing service provider data structure further includes legal services, which qualifies the stored data but does not

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add anything significant to the manipulative steps of providing a database, identifying a manufacturing service provider or a hyper link, sending user data, allowing user to obtain additional information from the hyperlink, receiving order information and placing order. Therefore, this data, " legal services" qualifies as non functional since there is no interrelationship between " legal services "and the manipulative steps of claim 1 - it does not matter what type of data or non functional descriptive material is claimed. In other words, the invention is not in the type of data i.e. pertaining to legal services, contracting terms and details of the fabricators, being claimed. The type of data stored is extraneous information. Thus, the claim is conceptually reduced to the manipulative steps of claim 1, that is : providing a database, identifying a manufacturing service provider or a hyper link, sending user data, allowing user to obtain additional information from the hyperlink, receiving order information and placing order. Therefore, the differences between the recited limitations of claim 3 and the prior art of Thackston are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The manipulative steps of claim 1, as cited above, would be performed the in the same manner regardless of the data, that is pertaining to legal services, data about fabricators, their terms and conditions for contracting their services. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any type of data in the database, because such data

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does not functionally relate to the steps in the method steps of claim 1 and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

5. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6.1. Claims 1-2, 4-9, 11-14, 22-23, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thackston in view of Bissonette and further in view of Elance.

Reference claims 1, and 4-5, Thackston discloses, in a contract manufacturing framework, a method of providing access to manufacturing service and manufacturing management services that can be contracted, the method for comprising the steps of:

(a) providing a database including a plurality of manufacturing service provider data structures, wherein each manufacturing service provider data structure includes a description of a particular manufacturing service provider and manufacturing services provided by the service provider that can be contracted, see at least col.4, lines 11-28, and col.5, lines 30-54 wherein repository of fabricators capability data corresponds to database, fabricators correspond to the plurality of service providers and the information on fabricators and their capabilities correspond to the description of manufacturing service providers and their services that can be contracted);

(b) identifying a particular manufacturing service provider data structure based on request data from a user and (d) sending the user the identified manufacturing service provider data structure so as to identify to the user a particular manufacturing service provider, see at least col.5, lines 30-54, which discloses that prime

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contractor[corresponds to the claimed "user"] is able to search and identify a fabricator [manufacturing service provider] as per his requirements[request data] and the data relevant to the manufacturing service provider including such as his location, experience, machinery and process capabilities, etc. are provided to the prime contractor[user]); (f, and h) receiving order information for a new order.....in the database, and placing the new order... see col.5, line 30-col.6, line 9, which discloses that the fabricator, that is the manufacturing service provider receives order information for bidding, negotiation and order placement from the user, that is a prime contractor.

Thackston discloses storing and using budget schedule documents, see col.14, lines 6-41 , that is PDM 335 and electronic document data module 840 stores information for referral , such as budget schedules, but does not disclose checking budget constraints, wherein budget constraints are calculated by comparing cost of the new order plus part order costs against an ordering budget to determine whether the cost of the new order would exceed the ordering budget. However, Bissonette in the same field of endeavor, that is a financial management controlling orders placement, teaches the missing limitation, see at least col.5, lines 42-51, " *The system automatically checks the transaction against all limits, it processes that transaction using the rules designated for this card debiting the default accounts and issuing a payment authorization to the payment authority* 46. ***If the transaction does not pass the internal checks, such as exceeding an internal company single purchase limit or would cause a budget item to be exceeded, the transaction can be flagged for internal resolution. The system can be configured to go ahead and authorize payment for the purchase or it can be held.***" . In view of Bissonette, it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified

Thackston to incorporate Bissonette's teaching of checking budget constraints, wherein budget constraints are calculated by comparing cost of the new order plus part order costs against an ordering budget to determine whether the cost of the new order would exceed the ordering budget because it would ensure that the purchase amount is within the allocated funding otherwise the transaction is flagged for internal resolution.

Thackston does not disclose that database includes a plurality of hyperlinks, (c) identifying a particular hyperlink based on the request data and (d) allowing the user to obtain additional information utilizing the identified hyperlink wherein the hyperlink is capable of being utilized to obtain information concerning patent licensing/multi-country licensing. However, in the field of same endeavor, that is providing companies information on contractors for providing procurement services, vendor network , administrative support services, Business strategy, engineering services, services for patent licensing/multi-country patent licensing projects, Elance (see complete article) discloses storing web based hyperlinks for these services identifying a particular hyperlink based on the request data and allowing the user to obtain additional information utilizing the identified hyperlink, wherein the hyperlink is capable of being utilized to obtain information concerning patent licensing/multi-country licensing. In view of Elance, it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Thackston to incorporate Elance's feature of storing hyperlinks for these services identifying a particular hyperlink based on the request data and allowing the user to obtain additional information utilizing the identified hyperlink, wherein the hyperlink is capable of being utilized to obtain

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information concerning patent licensing/multi-country licensing because, as explicitly disclosed in Elance, see page 1, it would provide Thackston easy access to the network of high-quality fabricators and other service providers, such as Vendor network, administrative services, and to safe-guard their new products/invention nationally and globally by obtaining information on patent licensing and multi-country patent licensing services.

Regarding claim 2, Thackston teaches that the service provider data structures include data concerning contracting the manufacturing service providers for manufacturing services and legal services (see at least col.13, lines 11-42, col.25, lines 26-53,).

Note: The examiner would like to present the following analysis concerning the limitations recited in claim 2, though Thackston, as stated above, discloses these limitations. Claims 1-2 are method/process claims wherein the novelty of invention lies in the manipulative steps. Claim 2 recites that the service provider data structure includes data concerning contracting of the manufacturing service providers, which qualifies the stored data but does not add anything significant to the manipulative steps of providing a database, identifying a manufacturing service provider or a hyper link, sending user data, allowing user to obtain additional information from the hyperlink, receiving order information and placing order. Therefore, this data, "concerning contracting of the manufacturing service providers" qualifies as non functional since there is no interrelationship between "concerning contracting of the manufacturing

service providers "and the manipulative steps of claim 1 - it does not matter what type of data or non functional descriptive material is claimed. In other words, the invention is not in the type of data i.e. pertaining to concerning contracting of the manufacturing service providers, terms and details of the fabricators, being claimed. The type of data stored is extraneous information. Thus, the claim is conceptually reduced to the manipulative steps of claim 1, that is: providing a database, identifying a manufacturing service provider or a hyper link, sending user data, allowing user to obtain additional information from the hyperlink, receiving order information and placing order. The manipulative steps of claim 1, as cited above, would be performed the in the same manner regardless of the data, that is pertaining to legal services, data about fabricators, their terms and conditions for contracting their services. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any type of data in the database, because such data does not functionally relate to the steps in the method steps of claim 1 and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Same analysis applies to claims 9 and 23.. In claim 9, which is a computer program product claim, the type of stored data, that is concerning contracting of the manufacturing service providers, information about the fabricator, etc. is nonfunctional descriptive material because it is not interrelated to the computer readable medium to

implement a positive function, - it is just being held in the medium. As a result, this data does not limit the claim.

Regarding claims 6-7, Thackston discloses that the database is accessed utilizing a network/Internet (see at least col. 9, lines 44-52).

Regarding claims 8-9, 11-14, 22-23, 25-28, their limitations are closely parallel to the limitations of claims 1-2, 4-7, already analyzed above and therefore these claims are also analyzed and rejected on the same basis.

6.2. Claims 3, 10 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thackston in view of Bissonette and further in view of Elance.

Regarding claim 3, Thackston in view of Bissonette and further in view of Elance, as analyzed above for claim 2, discloses a method of providing access to contracting services to manufacturing service providers data structures including information about the manufacturing service providers and data concerning contracting the services, and placing new orders for manufacturing by the users. Claims 1-3 are method/process claims wherein the novelty of invention lies in the manipulative steps. Claim 3 recites that the manufacturing service provider data structure further includes legal services, which qualifies the stored data but does not add anything significant to the manipulative steps of providing a database, identifying a manufacturing service provider or a hyper link, sending user data, allowing user to obtain additional information

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from the hyperlink, receiving order information and placing order. Therefore, this data, “legal services” qualifies as non functional since there is no interrelationship between “legal services” and the manipulative steps of claim 1 - it does not matter what type of data or non functional descriptive material is claimed. In other words, the invention is not in the type of data i.e. pertaining to legal services, contracting terms and details of the fabricators, being claimed. The type of data stored is extraneous information. Thus, the claim is conceptually reduced to the manipulative steps of claim 1, that is : providing a database, identifying a manufacturing service provider or a hyper link, sending user data, allowing user to obtain additional information from the hyperlink, receiving order information and placing order. Therefore, the differences between the recited limitations of claim 3 and the prior art of Thackston are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The manipulative steps of claim 1, as cited above, would be performed the in the same manner regardless of the data, that is pertaining to legal services, data about fabricators, their terms and conditions for contracting their services. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any type of data in the database, because such data does not functionally relate to the steps in the method steps of claim 1 and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

With regards to claims 10 and 24, the limitations are closely parallel to the limitations of claim 3 and is analyzed and rejected on the same basis. In claim 24, which is a computer program product claim, the type of stored data, that is legal services, contracting terms of the fabricator, information about the fabricator is nonfunctional descriptive material because it is not interrelated to the computer readable medium to implement a positive function, - it is just being held in the medium. As a result, this data does not limit the claim.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,446,053 to Elliott discloses a computer-implemented method and system for producing a proposal for a construction project, wherein the system provides a database including a plurality of contracting service providers data structure/information, such as for construction professionals, architects, designers, carpenters, masonry subcontractors, electrical subcontractors, building inspectors, attorneys [legal services], etc. 9see at least abstract, col.3, line 59-col.5, line 6 and col.9, line 27-col.11, line 6). This reference in view of Bissonette and further in view Elance can be used to render claims 1-14 and 22-28 obvious.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG/June 5, 2005